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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,164	12/31/2003	Motohiro Takano	Q79102	6958

7590 12/05/2005
Koda & Androlia
2029 Century Park East
Suite 1140
Los Angeles, CA 90067-2983

EXAMINER

COONEY, JOHN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,164

Applicant(s)

TAKANO ET AL.

Examiner

John m. Cooney

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 2,3 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1105</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicant's arguments filed 9-27-05 have been fully considered but they are not persuasive.

Rejections are withdrawn in light of applicants' amendments and properly filed terminal disclaimer. Any reference not applied in this Office action is hereby retained as being art of interest for its disclosure of relevant additive materials in the art.

Claim Objections

Claim 2 is objected to because of the following informalities: The specifications for performing the German Automobile Industry Association VDA278 test need to be provided for the record. Appropriate correction is required.

Claims 3 and 5 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations of these claims have been inserted into claim 1.

The following rejections are set forth in light of applicants' amendments:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh et al.(5,990,186).

Katoh et al. disclose polyurethane sealing materials comprising polyurethane foams prepared from material components including antioxidants, antiozonants, catalysts, isocyanates, and polyester polyols prepared from dimer acid initiators having molecular weights as claimed (see abstract, column 4 lines 5-29, column 6 lines 22-35, 57-60, column 17 lines 44-46, & 59 et seq, column 18 lines 25-53, claim 12, and the tables & examples, as well as, the entire document).

Katoh et al. differs from applicants' claims in that blends of the respective antiozonants and antioxidants specifically required to have molecular weights within the ranges of values claimed by applicants are not particularly demanded. However, within Katoh et al. species of compounds as claimed by applicants are recited as being employed for purposes of imparting their respective antioxidant and antiozonant effects

in articles formed (see again column 4 lines 17-37, column 17 lines 64-65 and column and 18 lines 25,26,28,29, and 49-53) . Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the disclosed ozone inhibiting and antioxidant compounds disclosed by Katoh et al. in combination within the preparations of Katoh et al. for the purpose of imparting their respective antioxidant and antiozonant effects to articles realized in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Applicants' reply and results have been considered in light of the above rejection. However, applicants' have not made a sufficient showing of new or unexpected results commensurate in scope with the scope of the claims attributable to employment of the combinations of antioxidants and antiozonants as defined by the claims in the compositions as claimed.

Claims 1-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clauss(5,869,565).

Clauss discloses polyurethane sealing materials comprising polyurethane foams prepared from material components including antioxidants, antiozonants, catalysts, isocyanates, and polyols which read on the products as claimed (see the entire document).

Clauss differs from applicants' claims in that blends of the respective antiozonants and antioxidants specifically required to have molecular weights within the ranges of values claimed by applicants are not particularly demanded. However, within Clauss species of compounds as claimed by applicants are recited as being employed for purposes of imparting their respective antioxidant effects in articles formed.

Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the disclosed antioxidant compounds disclosed by Clauss in combination within the preparations of Clauss for the purpose of imparting their respective antioxidant and degradation inhibiting effects to articles realized in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Applicants' reply and results have been considered in light of the above rejection. However, applicants' have not made a sufficient showing of new or unexpected results commensurate in scope with the scope of the claims attributable to employment of the combinations of antioxidants and antiozonants as defined by the claims in the compositions as claimed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

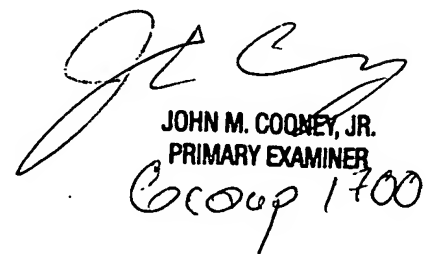
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN M. COONEY, JR.
PRIMARY EXAMINER
Cooney 1700